

## REMARKS

Claims 36, 37, and 39 have been amended. Upon entry of this amendment, claims 13, 14, 18, 21, 23, 25 and 27-41 will be pending in the above-identified application.

### Claim Rejections Under 35 U.S.C. § 112

Applicants request reconsideration of the rejection of claims 34-37, 39 and 41 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Examiner argues that claim 34 is unclear. Examiner argues that the "profile information of said user" is somehow unclear within the phrase "a plurality of terminal units for use by the user, each terminal unit being adapted for accumulating terminal use record information upon use of that terminal unit by the user and profile information of said user." Applicant believes that this terminology is clear and the claim can be deconstructed using the normal rules of the English language to show that the antecedent basis for "said user" is "the user" in the same clause and thus the user's profile information is that of "the user."

Examiner argues that claims 35, 39, and 41 are unclear due to the term "detachably connecting." The Office argues that this means both attached and detached. Applicant believes this term is perfectly clear and denotes that the attached part can be detached, not that it is detached. Applicant notes that "detachably" is used as an adjective. Applicant further notes that "detachably" as used herein has been condoned by the courts (*In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967)) and is cited in the MPEP at 2115.

Examiner argues that claims 36 and 37 are unclear. Applicant has modified claims to repair an obvious typographical error. Applicant believes this changes does not require a new search on the part of the Examiner.

Applicant argues that claim 37 is unclear do to the phrase "information corresponding to the use of each terminal unit used by the user." Applicant respectfully

disagrees. The phrase is used to note exactly which information is stored. The information stored is that information about each terminal that is actually used by the user. This phrase is clear.

Examiner argues claim 39 is unclear, Applicant has repaired an obvious typographical error to address this issue.

#### **Claim Rejections Under 35 U.S.C. § 103**

Applicants request reconsideration of the rejection of claims 13, 14, 18, 21, 23, 25, 27-33, 38 and 40 under 35 U.S. C. §103(a) as being unpatentable over by Dedrick (U.S. pat. No. 5,717,923) in view of Lee et al. (U.S. Pat. No. 6,751,459).

A *prima facie* case of obviousness is established when three basic criteria have been met. First, there must be some suggestion or motivation, either in the prior art cited by the examiner or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the references being relied upon to reject the claimed invention. Second, there must be a reasonable expectation of success. Third, the prior art reference or combination of references must teach or suggest all of the requirements of the claimed invention. MPEP 2143. In the instant case, the cited art fails to teach each and every limitation, there is not a reasonable expectation of success, and there is no motivation in the references to combine them. Further, the simple citation to each and every element in a claim does not suffice to maintain a rejection. The Supreme Court has specifically held that the "A patent composed several elements is not proved obvious by demonstrating that each element was, independently, known in the prior art." *KSR v Teleflex*, 500 U.S. \_\_\_\_\_ (2007).

Generally, Dedrick teaches;

"A method and apparatus for dynamically customizing electronic information to individual end users includes a client system containing a personal profile database which stores consumer information corresponding to individual end user(s) of the client system. The client system also includes a content adapter which compares electronic information received by the client system to the consumer information in the personal

profile database and customizes the electronic information to an individual end user based on this comparison. The client system also includes a client activity monitor which monitors actions taken by an individual end user when consuming electronic information and updates the personal profile database based on these actions. In one embodiment, the client activity monitor also monitors which actions are ignored by the individual end user and updates the personal profile database based on the consumer's interaction with the electronic information (that is, both the consumer's action and inaction). In one embodiment, an electronic information server containing a plurality of electronic information units is coupled to the client system via an electronic information distribution network and serves as the source of the electronic information." Abstract.

Generally Lee teaches:

"A method and apparatus for dynamically customizing electronic information to individual end users includes a client system containing a personal profile database which stores consumer information corresponding to individual end user(s) of the client system. The client system also includes a content adapter which compares electronic information received by the client system to the consumer information in the personal profile database and customizes the electronic information to an individual end user based on this comparison. The client system also includes a client activity monitor which monitors actions taken by an individual end user when consuming electronic information and updates the personal profile database based on these actions. In one embodiment, the client activity monitor also monitors which actions are ignored by the individual end user and updates the personal profile database based on the consumer's interaction with the electronic information (that is, both the consumer's action and inaction). In one embodiment, an electronic information server containing a plurality of electronic information units is coupled to the client system via an electronic information distribution network and serves as the source of the electronic information." Abstract.

Neither Dedrick nor Lee teach anything about a detachable device. A detachable device allows the information to be mobile and used differently by the collector of said information. All claims reciting this patentable distinction are allowable, and Applicant requests such allowance of claims 13, 14, 18, 21, 23, 27, 35, 37, 39, and 41. Applicant

allows requests allowance of claims depending therefrom which include claims 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, and 40.

Regarding claim 13, as to the limitation "a terminal unit for use by a user adapted for accumulating terminal use record information upon use of said terminal unit by said user and original profile information of said user generated on the basis of said terminal use record information" is not taught by Dedrick, even when supplemented by Lee. Each element must be taught by the prior art, or found obvious over the art. This is not the case as it relates to claim 13. The Examiner admits on page 4 of the instant office action that this element is not taught. Applicant argues that it is also not obvious. Examiner cites art that is aimed at server computers that are distant from the user, not the terminal used by the user. This is a patentable distinction, and thus claim 13 and all claims depending therefrom are novel and nonobvious. In fact this limitation is primary to the invention embodies in claim 13. Dedrick also does not teach comparing the used collected information with the original profile, but instead with a other information through a "content adapter." This deficiency is also not addressed by Lee.

Regarding claims 14 and 18, the recitation of "selecting means selects said provided information on the basis of said new profile information written in said storing means" is a patentable distinction which makes claim 14 and all claims which recite this limitation, or depend from claims which recite it, patentable. This is not taught by any reference cited by Examiner. Claims 14 and 18 are allowable based on this patentable distinction.

As to the Office's claim that GPS data is taught by column 17, lines 1-15 of Dedrick, Applicant respectfully disagrees. The lines are:

Thus, the method and apparatus of the present invention provides individual end users with high quality electronic information while preserving the end users' privacy. The user profile data corresponding to individual end users is stored in the client systems of those end users. Statistics regarding the psychographic, demographic and other profile characteristics of these users is returned to publishers and advertisers, however the information returned to these publishers and advertisers has no information to identify the identity of the end users. Thus, publishers and advertisers are able to provide the type of electronic information that end users want, thereby providing high quality electronic information. In addition, the client systems which the individual end users utilize are able to customize the electronic information to the individual end users based on the user profile data stored in the client systems.

Applicant asks for reconsideration an allowance of claims 28-33.

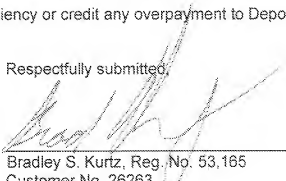
### Conclusion

Applicant respectfully requests withdrawal of the objections/rejections and believes that the claims as presented represent allowable subject matter. If the Examiner desires, applicant welcomes a telephone interview to expedite prosecution and is available at the telephone number below.

Applicant believes there is no fee due at this time. However, the Commissioner is hereby authorized to deduct any deficiency or credit any overpayment to Deposit Account No. 19-3140.

Respectfully submitted,

Dated: 5-14-07

  
Bradley S. Kurtz, Reg. No. 53,165  
Customer No. 26263  
314.259.5942